

REMARKS

Claims 11-13 are pending in this application. Independent claims 11 and 12 have been amended. Amended claims 11 and 12 and dependent claim 13 are believed to be in condition for allowance for at least the reasons provided below.

Claims 11-13 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In particular, the use of the term "sizing" in claims 11 and 12 was deemed unclear. Claims 11 and 12 have been amended to remove the term "sizing" from the claims.

Claims 11-13 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's admitted prior art (AAPA) in view of Dobbins, et al. (U.S. Patent No. 5,203,481). The Examiner explains that Applicant has indicated that tying a string in a loop around a recorder and suspending the string from the neck of a user is known. The Examiner further explains that this prior art method does not teach pulling the recorder apart and inserting it into the ring prior to reconnection, but that Dobbins teaches such a method for a bottle.

This combination of references represents an impermissible use of hindsight. *See, e.g., In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) ("[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art. . . . '[O]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'") Furthermore, Dobbins is non-analogous art and there is no teaching or motivation to combine these references. *See, e.g., In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Combining prior art references without evidence of . . . a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight."). One of ordinary skill in the art of recorders would not look to the art of drinking bottles for a solution to the problem of adequately supporting a recorder. Among other things, recorders must be suspended in a way that does not impair their playability, such as by interfering with their air holes. There is no such requirement for water bottles. This requirement has been added as a specific limitation of independent claim 11 and has support in the original drawings filed with the application (see FIG. 3).

In addition, neither the admitted prior art, nor Dobbins, teaches providing support for the recorder by lodging the ring around the upper section of the recorder. In Dobbins, a separate cap is placed over the bottle ring ("caddy") to hold it in place and support the

drinking bottle. *See, e.g.*, col. 2, lines 25-29; col. 4, lines 43-47. Accordingly, the bottle in Dobbins is not supported by an interference fit between the bottle and the ring (e.g., a ring lodged on the bottle neck), but is rather supported by the force exerted by the cap on the top of the ring.

Similarly, with respect to the admitted prior art, the admitted prior art was only used with respect to Baroque-style recorders which are one-piece recorders that include a substantial bulge along their shafts. The suspension force is therefore created between a bulge in the recorder and an upper surface of the string. The string loop was not used with, and would not work effectively with, the recorder claimed because the string loop would tend to become enlarged through loosening of the knot or stretching of the string, and hence slide toward the mouthpiece, partially obstructing the mouthpiece air hole. *See* Perry Decl., ¶ 6.

Furthermore, objective evidence of non-obviousness *must* be considered when present. *See, e.g.*, MPEP 716.01(a). “Affidavits or declarations containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103.” MPEP 716.01(a). Accompanying this response, Applicant has submitted a substantial amount of evidence of non-obviousness (e.g., secondary considerations) in the form of declarations and exhibits. This evidence shows that the invention described and claimed in this application would not have been obvious to one of ordinary skill in the art at the time the invention was made.

A long-felt but unsolved problem for the music educator in classroom teaching the recorder was that whenever there was a change of activity from recorder playing to other activities such as singing, movement, or playing other instruments, the recorder had to be set down, often on the desk or floor. These activity changes occur intermittently throughout a music class period, thus leading to disruption of the teaching program, problems in hygiene, confusion of ownership, and delays in resuming recorder work. *See, e.g.*, Declaration of Dr. Andrew M. Perry (“Perry Decl.”), ¶ 3; Declaration of Timothy S. Brophy, PH.D. (“Brophy Decl.”), ¶ 2; Declaration of Barry Alan Bowe (“Bowe Decl.”), ¶ 2; Declaration of Betty P. Coffman (“Coffman Decl.”), ¶ 2; Declaration of Laurie F. Zentz (“Zentz Decl.”), ¶ 2; Declaration of Emily Baxter (“Baxter Decl.”), ¶ 2; Declaration of Fonda C. Lockhart (“Lockhart Decl.”), ¶ 2; Declaration of Konnie Saliba (“Saliba Decl.”), ¶ 2; Declaration of Shawn Funk (“Funk Decl.”), ¶ 2; Declaration of Jay R. Wucher (“Wucher Decl.”), ¶ 2.

Depicted in Exhibit A to Perry Decl., a common type of recorder used in music education is the baroque-style recorder. Baroque-style recorders feature a large bulge above

the fingering holes along the shaft of the recorder. Although the admitted prior art string-tying approach provided a partial solution for the above-mentioned problems with respect to this common baroque-style recorder, the string-tying approach has never gained widespread acceptance or success due to its numerous drawbacks. *See* Perry Decl., ¶¶ 4-6.

These drawbacks include, for example, the fact that this method could only be used effectively with recorders, such as baroque-style recorders, that included a bulge in their shaft design. It could not be effectively used with renaissance-style recorders (such as depicted in Exhibit B to Perry Decl.) because the shafts of these recorders do not include bulges that can serve to prevent sliding movement of a string fastened around the recorder. If used with these recorders, the string would most likely end up directly below the mouth piece, partially blocking the air hole below the mouth piece. In addition, the need to tie the string into loops is time consuming for the teacher. It is also difficult to tie the loop to closely match the size of the recorder shaft, and maintaining precise consistency in the size of the loops is nearly impossible. Furthermore, the string loop typically loses its shape over time because of slippage of the knot or stretching of the string loop. Because of these and other deficiencies, the string-tying solution is inherently unreliable, and has therefore failed to provide a satisfactory solution to the problems of the industry. *See, e.g.,* Perry Decl., ¶¶ 6-7; Brophy Decl., ¶ 3; Bowe Decl., ¶ 3; Coffman Decl., ¶ 3; Zentz Decl., ¶ 3; Baxter Decl., ¶ 3; Lockhart Decl., ¶ 3; Saliba Decl., ¶ 3; Funk Decl., ¶ 3; Wucher Decl., ¶ 3.

Applicant's company, Peripole-Bergerault, Inc. ("Peripole") was the first company to introduce a recorder ring, and did so in 1996. *See* Perry Decl., ¶ 8; Brophy Decl., ¶ 4; Bowe Decl., ¶ 4; Coffman Decl., ¶ 4; Zentz Decl., ¶ 4; Baxter Decl., ¶ 4; Lockhart Decl., ¶ 4; Saliba Decl., ¶ 4; Funk Decl., ¶ 4; Wucher Decl., ¶ 4. Peripole's first commercial embodiment of Dr. Perry's (Applicant's) invention disclosed in this application is known as the Halo[®] recorder ring. Beginning almost immediately following its introduction, the Halo[®] recorder ring has enjoyed tremendous commercial success. A Halo[®] recorder ring has accompanied each renaissance-style recorder sold by Peripole since its introduction of the recorder ring in 1996. Peripole's sales of its renaissance-style recorders have grown steadily and significantly since the introduction of the Halo[®] recorder ring. Peripole now sells over two hundred-fifty thousand recorders accompanied by the Halo[®] recorder ring each year. *See* Perry Decl., ¶¶ 10, 18-20.

Applicant's recorder ring invention provided a solution to the long-felt problems of the industry without the deficiencies of the prior art string-tying approach. Applicant's invention includes a separate ring attached to a strap, wherein the ring is disposed around the

recorder and is held in place by an interference fit between the ring and the shaft. Applicant's invention represents a major and significant innovation and improvement over the occasional string-tying approach for numerous reasons.

Among other things, this invention provides a recorder suspension device that can be used effectively with a recorder (such as a renaissance-style recorder) that has a smooth, tapered shaft without any ridges or bulges (*see* Exhibit D). Using this invention, the teacher's valuable time and efforts are no longer consumed by tying knots in strings to fit around the recorder or by fixing loops that stretch or have knots that slip. The recorder ring can be manufactured of a resilient material that will maintain its size and shape over time. The recorder ring can also be manufactured to closely match the size of a recorder shaft at a specific point, thus providing precise consistency in the size of the ring as well as in the positioning of the ring on the recorder. It is therefore possible to assure the exact placement of the ring on the shaft of the recorder in a location where the ring and strap will not interfere with fingering of the recorder or passage of air through its wind passageway. For each of the foregoing reasons and others, Dr. Perry's recorder ring provides a tremendously more reliable recorder suspension device than the string loop. *See* Perry Decl., ¶¶ 10-11; Brophy Decl., ¶¶ 4, 7; Bowe Decl., ¶¶ 4, 7; Coffman Decl., ¶¶ 4, 7; Zentz Decl., ¶¶ 4, 7; Baxter Decl., ¶¶ 4, 7; Lockhart Decl., ¶¶ 4, 7; Saliba Decl., ¶¶ 4, 7; Funk Decl., ¶¶ 4, 7; Wucher Decl., ¶¶ 4, 7.

The importance of Dr. Perry's recorder ring invention is further attested to by the efforts of others to copy this invention. *See, e.g., Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1379-80, 56 USPQ2d 1065, 1079-80 (Fed. Cir. 2000) (holding that copying and product acclamations are indicia of nonobviousness.). These efforts include both direct copying of Peripole's commercial embodiment of the recorder ring as well as the adoption of the invention's beneficial features of the invention in modified embodiments. *See* Perry Decl., ¶ 12; Brophy Decl., ¶ 8; Bowe Decl., ¶ 8; Coffman Decl., ¶ 8; Zentz Decl., ¶ 8; Baxter Decl., ¶ 8; Lockhart Decl., ¶ 8; Saliba Decl., ¶ 8; Funk Decl., ¶ 8; Wucher Decl., ¶ 8.

At least one competitor of Peripole, LMI, advertised and sold nearly exact copies of Peripole's first commercial embodiment of the claimed invention. *See* Exhibit E to Perry Decl.; *see also* Perry Decl., ¶ 12. Another competitor filed and obtained U.S. Patent No. 6,384,307 B1 for its slight modifications to Applicant's invention. *See* Exhibit F to Perry Decl.; *see also* Perry Decl., ¶¶ 12-13.

Along with copying, laudatory statements by competitors are also strong evidence of nonobviousness. *See, e.g., Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573,

1579, 42 USPQ2d 1378, 1384 (Fed. Cir. 1997) (holding that a competitor's advertising touting the advantages of an embodiment of the claimed invention is relevant evidence of nonobviousness.). LMI's advertisement in Exhibit E not only shows this competitor's attempt to copy and profit from Dr. Perry's invention, but also shows their laudatory statements regarding the unique benefits of Applicant's recorder ring. More particularly, in promoting its near identical copy of Peripole's original commercial embodiment of this invention, LMI praised the recorder ring invention as follows:

Check out this innovative way to keep track of your recorder. Just slip off the head joint of your recorder, slip on the Recorder Ring and slip the cord around your neck. Your students will live [*sic*, love] it. It will make life a breeze when it comes to lost recorders.

Exhibit F, p. 2. These laudatory statements regarding a competitors nearly exact copy of the initial commercial embodiment of Applicant's invention are convincing evidence of the originality and novelty (and hence nonobviousness) of Applicant's invention.

Finally, as evidenced by the numerous accompanying declarations, experts in the music and music education industries have recognized both the novelty and importance of Dr. Perry's invention. *See, e.g.,* Brophy Decl.; Bowe Decl.; Coffman Decl.; Zentz Decl.; Baxter Decl.; Lockhart Decl.; Saliba Decl.; Funk Decl.; Wucher Decl. The testimonies of industry experts regarding the originality and significance of the Applicant's invention is also strong evidence of its nonobviousness. *See, e.g., Corning Glass Works v. Sumitomo Electric USA Inc.*, 671 F.Supp. 1369, 1398, 5 USPQ2d 1545, 1569 (S.D. N.Y. 1987) *aff'd*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989) ("Praise for the invention [*is*] further evidence of the novelty and worth of the invention[.]").

For at least the foregoing reasons, reconsideration and allowance of claims 11-13 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.


Craig R. Rogers, Reg. No. 43,888

MARGER JOHNSON & McCOLLOM
1030 SW Morrison Street
Portland, OR 97205
(503) 222-3613

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ON January 30, 2003
Deanna Brusco

VERSION WITH MARKINGS TO SHOW CHANGES MADE

The claims have been amended as follows:

11. (Amended) A method for suspending a recorder from a neck of a user using a device that comprises a strap and a ring attached to the strap, the recorder comprising a lower section and an upper section joined at a juncture point, the recorder having a distal end belonging to the lower section and a proximate end belonging to the upper section, the recorder further having a mouthpiece at the proximate end, the upper section having a diameter that increases gradually from the juncture point to the mouthpiece, the method comprising the steps of:

[sizing the] selecting a ring sized to have an inner diameter defining an inner portion of the ring at least as large as the diameter of the upper section at the juncture point[,] and [further sizing the inner diameter of the ring to be] smaller than the diameter of the upper section at the mouthpiece;

[suspending the strap from the neck of the user;]

pulling the recorder apart at the juncture point, thereby separating the lower section from the upper section;

[then] inserting through the inner portion of the ring an end of the upper section that is associated with the juncture point and is opposite to the proximate end, and [then] sliding the ring towards the mouthpiece, the ring thereby becoming lodged around the upper section, wherein lodging the ring around upper section creates an interference fit between the upper section and the inner portion of the ring to support the recorder in a way that does not interfere with any of the air holes of the recorder; [and]

[then] reconnecting the lower and upper sections at the juncture point; and suspending the strap from the neck of the user.

12. (Amended) A method for suspending a recorder from a neck of a user using a device that comprises a strap and a ring attached to the strap, the recorder comprising a lower section and an upper section joined at a juncture point, the recorder having a distal end belonging to the lower section and a proximate end belonging to the upper section, the recorder further having a mouthpiece at the proximate end, the upper section having a diameter that increases gradually from the juncture point to the mouthpiece, the method comprising the steps of:

[sizing] selecting [the] a ring [to have] having an inner diameter at least as large as the diameter of the upper section at the juncture point[,] and [further sizing the inner diameter of the ring to be] smaller than the diameter of the upper section at the mouthpiece;

suspending the strap from the neck of the user;

pulling the recorder apart at the juncture point, thereby separating the lower section from the upper section; and

[then] inserting through the ring an end of the upper section that is associated with the juncture point and is opposite to the proximate end, and [then] sliding the ring towards the mouthpiece, the ring thereby becoming lodged around the upper section.

13. The method of claim 12, further comprising reconnecting the lower and upper sections at the juncture point.